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10/729,973	12/09/2003	William Y. Sun		2202

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EXAMINER

KASZTEJNA, MATTHEW JOHN

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/729,973
Filing Date: December 9, 2003
Appellant(s): William Y. Sun

Clyde Coughenour
For Appellant

REQUEST FOR RECONSIDERATION AND REHEARING

It is respectfully requested that the Decision on Appeal, dated March 8, 2007 in the above-identified application be scheduled for rehearing and reconsideration on the written record, as supplemented below. It is believed that the Board erred in reversing the rejection of claims 1 and 8 under 35 U.S.C. §102, finding that the claims were not anticipated by the Panduit reference.

Period for Reply

The Appellant may file a reply to this request within two (2) months of the mailing date of this request for rehearing. After the expiration of this period, plus appropriate time for

mailing, this application and request will be forwarded to the Board of Patent Appeals and Interferences for consideration.

Summary of the Invention

The invention as claimed involves an instrument (tongue stabilizer) for use with a laryngoscope blade during intubation procedures.

Issues on Appeal

The issues on appeal are as follows:

1) 35 U.S.C. §102 rejection of claims 1 and 8 as being anticipated by Panduit (Product Bulletin, "ABM112 Adhesive Backed Cable Tie Mount," pp. 28-29, 1999). Panduit, the prior art used in the rejection, discloses a plate and all of the structural limitations that are expressly recited in claim 1 (a plate having a top surface, a bottom surface, a forward end, a rear end, a first side, a second side and a central area). Panduit does not specifically state that the plate is a "tongue-engaging plate." The issue is whether Panduit's plate can be considered as a "tongue-engaging plate."

Decision by the Board

The Board of Appeals reversed the 35 U.S.C. §102 rejection of claims 1 and 8.

The decision states, on page 3, that "The issue in this appeal is whether Panduit describes a device which comprises a tongue-engaging plate as required by claim 1, anticipating the claim under 35 U.S.C. §102(b). This issue turns on the proper interpretation of the phrase "tongue-engaging plate" which is recited in claim 1."

The decision also states "Giving "tongue-engaging plate" its broadest reasonable interpretation as it would be understood by the skilled worker in view of the specification, we interpret it as a structure which, when attached to a laryngoscope blade and in contact with the tongue, **must be capable of confining and holding the tongue on its surface**" (with emphasis added) (bottom of page 4 of the decision).

The decision also states that "the dispositive issue is not whether the cable mount is capable of contacting ("engaging") the tongue, but whether it can confine and hold it on its top surface" (page 6, lines 5-7 of the decision). In addition, it states "In reaching this determination, we have interpreted the "tongue engaging plate" to be more than a statement of intended use of the claimed device, but also to require that the plate is able to confine and hold the tongue in order to control it during an intubation procedure. In other words, we interpret structure from it. The specification describes this structure as an "elongated" plate having preferred spoon or concave shapes (Specification 4: 14-17) to hold the tongue in place."

Finally, the decision concludes that "The skilled worker would not have *reasonably* interpreted the tongue-engaging plate so broadly that it would cover the two-tiered cable mount surface described by Panduit. Yes, Panduit's mount could be adhesively attached to a laryngoscope blade, inserted into the mouth and placed in contact with the tongue. But we agree with Appellant that there is nothing about its upper surfaces that would reasonably suggest it could be used to hold the tongue."

Issue for Reconsideration

The issue to be addressed in this reconsideration is whether the Board erred in reading a limitation (“capable of confining and holding the tongue on its surface”) from the specification into the claims when the Board interpreted the term “tongue-engaging plate”.

Analysis of the Issues

The Board interpreted the term “tongue-engaging plate” as “a structure which, when attached to a laryngoscope blade and in contact with the tongue, **must be capable of confining and holding the tongue on its surface**” (with emphasis added) (bottom of page 4 of the decision). It is our position that the Board improperly interpreted claim 1 when it read this limitation (“capable of confining and holding the tongue on its surface”) from the specification into the claims.

First, the Board concluded the term “engaging” in the context of the claim and specification to mean that the plate “comes into contact with” the tongue (page 4 of the decision). If the Board decision was based only on this interpretation, the Board’s interpretation would have been consistent with the Federal Circuit’s claim construction of the term “engaging” in *Primos Inc. v. Hunter’s Specialties Inc.*, 451 F.3d 841, 847-48, 79 USPQ2d 1129, 1134-35 (The court agreed “that the district court correctly construed the term “engaging” to mean “to come into contact with” and “ordinarily construe claim terms to have their customary meaning as understood by a person of ordinary skill in the art.”) The Board also would not have improperly imported a material limitation from the specification. The term “tongue-engaging plate” would have been interpreted as a plate that is capable of engaging a tongue or coming into contact with

a tongue. Furthermore, since Panduit's plate is capable of coming into contact with the tongue as noted by the BPAI on page 6 of the decision, stating that "Panduit mount could be adhesively attached to a laryngoscope blade, inserted into the mouth, and placed in contact with the tongue," Panduit's plate would have met this claim limitation (a "tongue-engaging plate") and thus, the examiner's rejection would have been affirmed.

However, the Board went too far by requiring "a structure which, when attached to a laryngoscope blade and in contact with the tongue, must be capable of confining and holding the tongue on its surface" (bottom of page 4 of the decision). This function and the structure for this function are not expressly recited in the claim. We believe that the Board improperly relied on a portion of the specification that describes the preferred embodiment because the Board supported its determination by stating (on page 6 of the decision) that "the specification describes this structure generally as an "elongated" plate having preferred **spoon or concave shapes (Specification 4: 14-17) to hold the tongue in place**" (with emphasis added). However, the spoon or concave shape is only present in the preferred embodiment, not in the other disclosed embodiments. The specification further discloses that a spoon shape is preferred as it tends to cradle the tongue and hold it within the concavity of the tongue-engaging plate (on page 5, lines 5-6, of the specification).

Furthermore, the Board's interpretation of "tongue-engaging plate" is inconsistent with the specification because the specification describes that a **flat plate** can function adequately to confine the tongue and prevent it from slipping and obstructing and/or obscuring the throat passage (on page 5, lines 3-5, of the specification). It is not clear whether a flat plate would be

“capable of confining and holding the tongue on its surface.” An applicant is entitled to be his or her own **lexicographer** and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). *See In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). However, the applicant in this case did not set forth an explicit definition for the term “tongue-engaging plate” in the specification. Instead, the specification discusses that the both the flat plate embodiment and the concave shaped embodiment are both capable of engaging the tongue.

In addition, claim 3, depending on claim 1, adds only one limitation (the tongue-engaging plate having a concavity). The Board’s interpretation of “tongue-engaging plate” would render claim 3 improper under 35 U.S.C. § 112, 4th paragraph, because claim 3 would have the same limitations as claim 1, the independent claim.

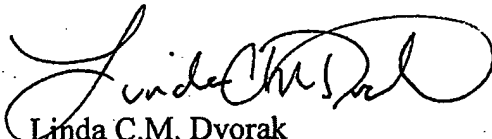
The Board also stated that “the skilled worker would not have reasonably interpreted the tongue-engaging plate so broadly that it could cover the two-tiered cable mount surface described by Panduit” (page 6 of the decision). However, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Even though Panduit is a nonanalogous art, or is not recognized as solving the problem solved by the claimed invention, nevertheless it discloses all the structural limitations recited in claim 1. The fact that it is a nonanalogous art is not germane to an anticipatory rejection.

For the reasons above, we believe that the Board improperly imported a limitation from the specification and it should have affirmed the examiner's rejection but for the misinterpretation of the term.

Conclusion

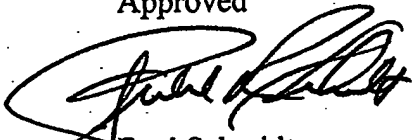
For the reasons set forth above, it is respectfully requested that the decision of the Board of Patent Appeals and Interferences dated March 08, 2007, be reconsidered and that the 35 U.S.C. §102(b) rejection of Appellant's claims 1 and 8 as being anticipated by Panduit be Affirmed.

Respectfully submitted,

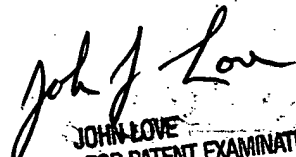


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